

REMARKS/ARGUMENTS

Claims **1-6, 8-14**, and **16-21** were pending in this application. According to the April 6, 2006 Office Action, claims **1-6, 8-14**, and **16-21** were rejected.

We have amended independent claims **1** and **21** and dependent claims **3-6, 12-13, 16-17**, and **19-20**. We have cancelled dependent claim **2, 8-11, 14**, and **18**. We have added new dependent claims **23-39**, which depend from claim **1**. The amendments do not introduce any new matter.

Accordingly, independent claims **1** and **21**, and dependent claims **3-6, 12-13, 16-17, 19-20**, and **23-39** are under consideration.

Summary of Claim Amendments

We have amended independent claims **1** and **21** to recite particular embodiments that we, in our business judgment, have currently determined to be commercially desirable.

We have amended dependent claim **3-6, 12-13, 16-17**, and **19-20** in view of the changes to claim **1** and to further protect desirable embodiments. We have cancelled claims **2, 8-11, 14**, and **18** to pursue at this time particular desirable embodiments. We have added new claims **23-39** to further protect desirable embodiments.

We will pursue the subject matter of the previously presented claims and cancelled claims in one or more continuing applications.

Response to the Rejection of Claims under 35 U.S.C. § 112

With respect to the rejection of previously presented claims **1-6, 8-14**, and **16-20** under 35 U.S.C. § 112, second paragraph, as being indefinite, the Examiner characterized the rejection as claim **1** being “directed to a method for simulating the trading of carbon dioxide equivalent emission reductions using an electronic trading application yet there is no step of simulating the trading of carbon dioxide.” We respectfully submit that the Examiner has not made a *prima facie* case of indefiniteness under 35 U.S.C. § 112, second paragraph, with respect to these claims.

Specifically, we are unaware of any requirement that phrases set forth in the preamble of a claim must be accomplished by the claim steps, contrary to the Examiner’s assertion. Rather, the definiteness inquiry focuses on whether those skilled in the art would understand the scope of the claim when the claim is read in light of the rest of the specification. The Examiner has failed to indicate why one skilled in the art would not understand the scope of the steps of previously presented claim **1** and as such, has not made a *prima facie* case of

indefiniteness under 35 U.S.C. § 112, second paragraph. In addition, we submit that one skilled in art would clearly understand the scope of this claim.

Nonetheless, we submit that the Examiner's rejection of claim **1** and the corresponding dependent claims is now moot in view of the amendment to claim **1** to recite a particular embodiment that we have determined to be commercially desirable.

With respect to the Examiner's rejection of previously presented claim **21** under 35 U.S.C. § 112, second paragraph, as being indefinite, the Examiner characterized the rejection as the claim being "directed to a system and therefore it is unclear which class of invention the claim is directed towards, a method or an apparatus." We submit that because previously presented claim **21** recites a "system", it is clear that the claim is directed at an apparatus, rather than a method. Nonetheless, to expedite prosecution of this application, we have amended claim **21** to recite an "apparatus" and submit that an apparatus is equivalent to a system. In view of the foregoing, we respectfully request withdrawal of the rejection of the claims under 35 U.S.C. § 112, second paragraph.

Response to the Rejection of Claims under 35 U.S.C. § 103(a)

The Examiner rejected previously presented claims **1-6**, **8-14**, and **16-21** under 35 U.S.C § 103(a) as being unpatentable over Pugliese III et al., U.S. Publication No. US 2001/0044751 (hereinafter Pugliese) in view of Messmer et al., U.S. Publication No. US 2001/0037278 (hereinafter Messmer) and in further view of Sowinski, U.S. patent No. 6,601,033 (hereinafter Sowinski). We respectfully submit that Pugliese, Sowinski, and Messmer, alone or in combination, fail to teach, suggest, or disclose any of amended claims **1**, **3-6**, **12-13**, **16-17**, and **19-21**, and new claims **23-39**. Specifically, amended claim **1** now recites in part a method comprising,

in response to a simulated event that is separate from a trading of credits of carbon dioxide equivalent emission reductions, changing for the simulated entity at least one of:

a cost to generate internal reductions of carbon dioxide equivalent emissions,

a cost to generate reductions of carbon dioxide equivalent emissions in order to generate credits of carbon dioxide equivalent emission reductions, and

a volume of credits of carbon dioxide equivalent emission reductions.

Pugliese discloses an “online” system that allows shoppers to purchase “products and services” from merchants. (Pugliese, paragraphs 8-11). Contrary to claim 1, however, Pugliese has nothing to do with “carbon dioxide equivalent emissions” and as such, does not teach, suggest, nor disclose the system, “*in response to a simulated event ..., changing ... at least one of: a cost to generate internal reductions of carbon dioxide equivalent emissions, a cost to generate reductions of carbon dioxide equivalent emissions in order to generate credits of carbon dioxide equivalent emission reductions, and a volume of credits of carbon dioxide equivalent emission reductions,*” as claim 1 recites.

Sowinski discloses a system in which “individuals” can “collect pollution credits” based on “the amount of reduced pollution they achieve” and then sell these credits to buyers. (Sowinski, column 4, line 59 to column 5, line 32; column 8, line 53 to column 9, line 7). Notably, while Sowinski appears to disclose that the pollution emission reductions may be associated with the “[r]eduction and/or elimination of Carbon Monoxide,” (see Sowinski, column 6, lines 64-65), Sowinski does not teach, suggest, nor disclose that the pollution emission reductions are associated with the reduction of “carbon dioxide equivalent emissions,” as claim 1 recites. As important, with respect to pollution emission reductions, Sowinski does not teach, suggest, nor disclose the system, “*in response to a simulated event [(let alone a real event)] that is separate from a trading of credits of [pollution] emission reductions, changing for the [individual] at least one of: a cost to generate internal reductions of [pollution] emissions, a cost to generate reductions of [pollution] emissions in order to generate credits of [pollution] emission reductions, and a volume of credits of [pollution] emission reductions,*” as claim 1 recites.

Messmer discloses a system for “valuating [an] asset”, which system includes a bidding simulation “to predict whether [a] bid can be expected to be a winning bid.” (Messmer, paragraphs 55-59; Figures 2 and 4). Contrary to claim 1, however, Messmer has nothing to do with “carbon dioxide equivalent emissions” and as such, does not teach, suggest, nor disclose the system, “*in response to a simulated event ..., changing ... at least one of: a cost to generate internal reductions of carbon dioxide equivalent emissions, a cost to generate reductions of carbon dioxide equivalent emissions in order to generate credits of carbon dioxide equivalent emission reductions, and a volume of credits of carbon dioxide equivalent emission reductions,*” as claim 1 recites.

Accordingly, for the foregoing reasons we submit that Pugliese, Sowinski, and Messmer alone fail to teach, suggest, or disclose the above limitations of claim 1 and that the combination of these references thereby also fail to obviate these limitations of claim 1.

Accordingly, we submit that Pugliese, Sowinski, and Messmer, alone or in combination, fail to teach, suggest, or disclose claim **1**, in addition to claims **3-6**, **12-13**, **16-17**, **19-20**, and **23-39**, which depend there from.

Turning to independent claim **21**, this claim recites limitations similar to claim **1** and as such, we respectfully submit that Pugliese, Sowinski, and Messmer, alone or in combination, fail to teach, suggest, or disclose this claim for reasons similar to claim **1**.

We further submit that for the Examiner to rely on a reference as a basis for rejection of a claimed invention, the reference must be analogous prior art, or in other words, “the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned.” (MPEP 2141.01(a)). We submit that at least Pugliese is nonanalogous prior art.

Specifically, as indicated above, Pugliese has nothing to do with “*carbon dioxide equivalent emissions*” and as such, is not in the field of Applicants’ endeavor. In addition, as indicated at paragraphs 2-5 of the specification,

[e]missions reductions may qualify for accreditation under future international regulatory regimes, domestic regulatory regimes, or both. In an evolving CO₂e emission reductions trading market, entities ... may desire to simulate their participation prior to entry to gain a deeper understanding of the market.... It is therefore desirable to provide an electronic trading system for simulating the trading of carbon dioxide equivalent emission reductions....

As indicated, Pugliese is an online system for purchasing goods and services and is not directed at simulating a trading market to assist entities to gain a deeper understanding of the market prior to entering the market. Accordingly, Pugliese is not reasonably pertinent to the particular problem with which our invention is concerned. Accordingly, we submit that Pugliese is nonanalogous prior art and cannot form a basis for rejection of any of claims **1**, **3-6**, **12-13**, **16-17**, **19-21**, and **23-38**.

We further submit that there is no suggestion or motivation present in any evidence of record to combine the teachings of Pugliese and Sowinski, contrary to the Examiner’s assertion. Specifically, to establish a *prima facie* case of obviousness, the Examiner has the burden of showing, in part, that there is “some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.” (MPEP § 2143). The Examiner indicated that it would be obvious to combine the “‘goods’” of Sowinski with the “‘goods’” of Pugliese to “provide a reasonable means of trading” the goods of Sowinski.

We note that the goods of Pugliese are physical/tangible products. (Pugliese, paragraphs 8-11). On the contrary, the goods of Sowinski are “pollution credits”, or in other words, intangible assets. Accordingly, the “goods” of Sowinski are different from the “goods” of Pugliese. We also note that while Pugliese discloses the sale of “services,” services are also different from the intangible assets of Sowinski. As such, the Examiner has failed to indicate how the system of Pugliese “provides a reasonable means of trading” the goods of Sowinski since the goods of Sowinski are different from the goods and services of Pugliese. Accordingly, we submit that there is no suggestion or motivation present in any evidence of record to combine the teachings of Pugliese and Sowinski, contrary to the Examiner’s assertion.

Conclusion

Since Pugliese, Sowinski, and Messmer fail to teach or suggest the present invention as now set forth in claims **1, 3-6, 12-13, 16-17, 19-21, and 23-39**, we submit that these claims are clearly allowable. Favorable reconsideration and allowance of these claims are therefore requested.

We earnestly believe that this application is now in condition to be passed to issue, and such action is also respectfully requested. However, if the Examiner deems it would in any way facilitate the prosecution of this application, she is invited to telephone the undersigned representative at 212-294-7733.

Respectfully submitted,

/Glen R. Farbanish/

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Date

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